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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,630	05/09/2003	Ben Jones	10-1009US	7221
24923	7590	06/03/2005	EXAMINER	
<b>PAUL S MADAN</b> MADAN, MOSSMAN & SRIRAM, PC 2603 AUGUSTA, SUITE 700 HOUSTON, TX 77057-1130				FAYYAZ, NASHMIYA SAQIB
		ART UNIT		PAPER NUMBER
				2856

DATE MAILED: 06/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

(A)

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/936,630	JONES ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Nashmiya S. Fayyaz	2856	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 16 March 2005.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 28-48 is/are pending in the application.

4a) Of the above claim(s) 30-34 and 36-48 is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 28,29 and 35 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

- 1.) Certified copies of the priority documents have been received.
- 2.) Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
- 3.) Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____.
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>9/12/01</u>	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election with traverse of Group I in the reply filed on 3/16/05 is acknowledged. The traversal is on the ground(s) that the various embodiments are depicted by various figures indicating overlap and that all the limitations of independent claims 28/37 are necessarily included in each claim depending therefrom. This is not found persuasive because Figures have *not* been used to define the numerous embodiments disclosed but rather the groupings given illustrate how the claims do not relate to a single general inventive concept since the various groupings lack the same or corresponding special technical features as indicated. Further, claims 28 and 37 were listed generically indicating the overlap but again the further dependent claims lack the same or corresponding special features allowing for the separate groupings.

The requirement is still deemed proper and is therefore made FINAL.

2. Please note that claim 34 was erroneously grouped with group I and has been regrouped with Group V drawn to a sensor simulator.
3. Claims 30-34 and 36-48 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 3/16/05.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 28 is rejected under 35 U.S.C. 102(e) as being anticipated by Taylor et al- U.S. Patent # 5,950,629. As to claim 28, Taylor et al disclose a system for assisting a surgeon during surgery including an environmental data sensor (camera 259) and controller (computer 243) for automatically controlling the sensing modes of the sensor, see Fig. 10 and col. 20, lines 22 et seq.

6. Claim 28 is rejected under 35 U.S.C. 102(b) as being anticipated by JP-114852 (Satake et al). As to claim 28, Satake et al disclose a label paster including an environmental sensor (sensor 30) and a controller (CPU 15) which selects the mode of the sensor from a plurality of modes (0 and 1), see Abstract translation.

7. Claims 28 and 34 are rejected under 35 U.S.C. 102(b) as being anticipated by Parl et al- U.S. Patent # 5,883,598. As to claim 28, Parl et al disclose a position location system and method including a sensor (position sensors 12), and a controller (transmission sequencer microprocessor/microcontroller 36 and control station 22) where the operation of the sensor including multiple modes of system 10 in which one of the multiple modes is when a probe is transmitted to the base station sensors 12, see Figs. 1-2 and col.5, lines 40 et seq. As to claim 35, note Fig. 2 including a feedback control system including sequencer 36 for selecting the mode of operation (sleep or transmit) and a loop filter 44 operatively coupled to the sequencer.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 28, 29 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. As to claim 28, the preamble recites a device for "recording", however, there is no mention of recording in the body of the claim rendering the claim incomplete.

***Oath/Declaration***

10. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:  
Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

All inventors have not signed the oath.

***Allowable Subject Matter***

11. Claim 29 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nashmiya S. Fayyaz whose telephone number is 571-272-2192. The examiner can normally be reached on Mondays and Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hezron E. Williams can be reached on 571-272-2208. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
N. Fayyaz  
Examiner  
Art Unit 2856

nf  
5/26/05

  
HEZRON WILLIAMS  
SUPERVISORY PATENT EXAMINER  
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